THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte NORIMASA SASAKI, KOJI TAKAGI

_____

Appeal No. 96-3242
Application 08/458,012[1]

_____

ON BRIEF

_____

Before THOMAS, FLEMING and CARMICHAEL, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 20 through 25, all of the claims pending in the application. Claims 1 through 19 have been canceled.

[1]Application for patent filed June 1, 1995. According to appellants, this application is a continuation of application 08/111,829, filed August 25, 1993, abandoned, which is a continuation of application 07/640,105, Filed January 11, 1991, abandoned.

The invention relates to a data disc on which text data such as a dictionary or an encyclopedia is recorded. The text data recorded on the data disc is retrieved by obtaining retrieval item data on the basis of index data recorded on the data disc. The text data is associated with the retrieval item data which allows for the retrieval of the text data.

Independent claim 20 is reproduced as follows:

> 20. An optical disc recorded with data in a CD-ROM format and International Standards Organization (ISO) format standard 9660, the disc comprising a volume descriptor including a positioning information of a route directory and at least one file name data, a route directory and at least one file, the route directory including at least positioning data of the file and length data of the file, the file having literature supervising data, main text data including at least letter or character data and a plurality of index data for retrieving the main text data and being constituted as a tree structure, the literature supervising data being arranged in a lead position of the file and including address data of the plurality of index data and the main text data.

The reference relied on by the Examiner is as follows:

Miura et al. (Miura) 5,359,580 Oct. 25, 1994

Claims 20 through 25 stand rejected under 35 U.S.C. § 102 as being anticipated by Miura or in the alternative under 35 U.S.C.

§ 103 as being unpatentable over Miura.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the brief and the answer for the details thereof.

OPINION

After a careful review of the evidence before us, we do not agree with the Examiner that claims 20 through 25 are anticipated by the applied references.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136,
138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co***., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Appellants argue on pages 3 and 4 of the brief that Miura fails to teach the Appellants' claimed limitations as required

under 35 U.S.C. § 102. In particular, Appellants argue that Miura fails to teach a disc having recorded thereon a route directory including at least positioning data of a file and length data of the file, a volume descriptor including a positioning information of a route directory and at least one file name data, or that the recorded file has literature super-vising data as per claims 20, 22 and 23. Appellants further argue that Miura fails to teaches the retrieving method steps as recited in claims 21, 24 and 25. For example, claim 21 recites the step of reading out the volume descriptor, displaying a file name according to the volume descriptor, reading out and displaying the index data of the selected file using the literature supervising data and retrieving and displaying the index data of a lower layer according to the selected index data of a higher layer.

On page 3 of the answer, the Examiner argues under 35 U.S.C. § 102, that the claim record medium including the information content of the record medium stored thereon does

not make a new record medium. The Examiner argues that the claimed information content of the record medium as recited in the claims are not functionally related to the record medium structure.

We note that claims 21, 24 and 25 are directed to a method and not a record medium. Upon a careful review of Miura, we fail to find that Miura teaches these claimed method steps.

Turning to Appellants' claims 20, 22 and 23, we note the claims are reciting a disc having record data which performs a particular function dealing with the retrieval of data from the disc. Our reviewing court held that patentable weight must be given to a limitation which defines data stored on a disc that defines functional characteristics of the memory. ***In re Lowry***, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994). We find that the argued limitations recited in claims 20, 22 and 23 define a functional relationship with the memory. Therefore, we find that Miura fails to teach all of the limitations of

claims 20 through 25, and thereby the claims are not anticipated by Miura.

Claims 20 through 25 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Miura. On page 4 of the answer, the Examiner argues that it would have obvious to include the claimed information content on the record medium of Miura.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***,

73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied,*** 117 S.Ct. 80 (1996), ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

Upon a review of Miura, we fail to find any teaching or suggestion to modify Miura to obtain the Appellants' claimed invention. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a ***prima facie*** case. ***In re Knapp-Monarch Co.***, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); ***In re Cofer***, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

In view of the foregoing, the decision of the Examiner

rejecting claims 20 through 25 is reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JAMES T. CARMICHAEL Administrative Patent Judge	)	

vsh

Philip A. Girard
Limbach and Limbach
2001 Ferry Building
San Francisco, CA 94111